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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/762,816 | 01/22/2004 | William J. Shaw | 10527-455001 | 6207 |
| 26161 | 7590 | 01/29/2009 | EXAMINER | |
| FISH & RICHARDSON PC | | | STEWART, ALVIN J | |
| P.O. BOX 1022 | | | | |
| MINNEAPOLIS, MN 55440-1022 | | | ART UNIT | PAPER NUMBER |
| | | | 3774 | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 01/29/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

| | | |
|------------------------------|--------------------------------------|-----------------------------------------|
| Office Action Summary | Application No. 10/762,816 | Applicant(s) SHAW, WILLIAM J. |
| | Examiner Alvin J. Stewart | Art Unit 3774 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12/17/2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-25 and 33-40 is/are pending in the application.
 4a) Of the above claim(s) 34 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 19-25, 33 and 35-40 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 19-25, 33 and 35-40 have been considered but are moot in view of the new ground(s) of rejection.

NOTE: claims 21 and 22 are redundant to claim 19. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 20-25, 33 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litner US Patent 6,589,286 B1.

Litner discloses a tubular structure (10) comprising at least two fibers, the first fiber being a ceramic fiber and a second fiber made of metal, wherein the ceramic fiber is interwoven with the non-ceramic fiber and the device is in the form of a stent (see col. 5, lines 18-26). However, Litner does not disclose a metal made of stainless steel or Nitinol.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the metal of the Litner reference with a metal made of stainless steel and/or Nitinol because Applicant has not disclosed that by having a stainless steel or Nitinol provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's

invention to perform equally well with the biocompatible metal of the Litner reference because it would perform equally as well.

Therefore, it would have been an obvious matter of design choice to modify the Litner reference to obtain the invention as specified in claim 1.

Regarding claim 33, the Examiner interpreted the polymer element as the coating shown in col. 5, lines 36-47.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Isabella can be reached at 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

09/11/08

/Alvin J Stewart/

Primary Examiner, Art Unit 3774

Application/Control Number: 10/762,816
Art Unit: 3774

Page 4